

REMARKS

Claims 1-3, 5-12 and 15-25 are pending in this application. By this Amendment, independent claims 1, 2, 5, 6 and 8 are amended. No new matter is added. A Request for Continued Examination is attached. Reconsideration of the application in view of the above amendments and following remarks is respectfully requested.

The Office Action rejects claims 1-3, 5-12 and 15-25 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 7,149,974 B2 to Girgensohn et al. (hereinafter "Girgensohn"). The rejection is respectfully traversed.

An August 22, 2007 Office Action, in response to Applicants previously having amended the pending claims in this application, rejected all of then-pending claims 1-20 under 35 U.S.C. §102(e) as being anticipated by Girgensohn. In a November 20, 2007 personal interview, Applicants' representative discussed with Examiner Augustine claim amendments to overcome the Girgensohn reference. An Interview Summary regarding that application indicated that "[t]he Examiner notes that the discussion of the prior art rejection along with the proposed amendments might overcome the previous art rejection and will require further consideration and an updated search before making a final determination on allowability."

In view of the discussion undertaken during the personal interview, Applicants amended the claims as discussed during the personal interview. In response, a February 6, 2008 Final Rejection noted that the now-pending claims 1-3, 5-12 and 15-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Girgensohn. Specifically, that Office Action on page 3 indicated that Girgensohn "does not specifically and in detail teach a designation section for accepting, during the reproduction of the video data, an instruction from a user to designate one of the plural pieces of still picture data displayed on the screen." The Office Action went on to assert that such a feature was, however, considered obvious in view of the Girgensohn reference.

In response to the above, Applicants noted that Girgensohn, being commonly assigned to the Assignee of this application, and only available as prior art under 35 U.S.C. §102(e), was not available as a prior art reference to render obvious the subject matter of the pending claims under the provisions of 35 U.S.C. §103(c). In this regard, Applicants appropriately argued that the claims were clearly allowable over the Girgensohn reference based on the concessions made in the previous Office Action. This Office Action reasserts the Girgensohn reference and rejects all of the pending claims under 35 U.S.C. §102(e) as being anticipated by Girgensohn. The record is clear in this regard, however, that Girgensohn was considered, by this Examiner and the Office, not to explicitly or implicitly teach features recited in the pending independent claims. It is, therefore, unsupportable, based on the written record, to maintain a rejection of the subject matter of the pending claims under 35 U.S.C. §102(e). As is discussed briefly above, the February 6, 2008 Final Rejection specifically and unequivocally states "Girgensohn does not specifically and in detail teach a designation section for accepting, during the reproduction of video data, an instruction from a user to designate one of the plural pieces of still picture data displayed on the screen" (see page 3 of the Office Action, emphasis added). It is inappropriate that this Office Action, on page 3, now asserts that "Girgensohn further teaches a designation section for accepting, during the reproduction of the video data, an instruction from a user to designate one of the plural pieces of still pictured data displayed on the screen."

Applicants' representative attempted to discuss this matter with the Examiner during several telephone conferences conducted upon the receipt of this Office Action. Examiner Augustine remained unpersuaded by Applicants' representative's arguments that the piecemeal prosecution of this application to date have unduly burdened Applicants and potentially placed their intellectual property rights at risk.

As was previously agreed with the Examiner, Girgensohn fails to teach a picture display section for reproducing and displaying plural pieces of still picture data on the screen, a

designation section for accepting, during the reproduction of video data, an instruction from a user to designate one of the plural pieces of still pictured data on the screen; and a correlation section for, upon instruction entered by the user during the reproduction of video data correlating the designated one of the plural pieces of still pictured data with a reproduction time position of the video data as is varyingly recited, among other features, in the pending claims of this application. The Office Action alleges that col. 3, lines 39 and 40 of Girgensohn can reasonably be considered to teach certain aspects of the features recited in the pending claim by which "the user is in control of the presentation, in such that the user manipulates the display as the user sees fit." The relied-upon portions of Girgensohn, or any other portion of Girgensohn, do not teach a correlation section for, upon the instruction entered by the user during the reproduction of video data, correlating the designated one of the plural pieces of still pictured data with a reproduction time position in the video data as is recited, among other features, in the claims of this application. In attempting to allege that Girgensohn's selection of key frames is equivalent to "designating one of the plural pieces of still pictured data." The Office Action overlooks that Girgensohn fails to disclose "selecting key frames during reproduction of a video clip or a video composite (video data)." The parts of Girgensohn relied upon in order to loosely assert a rejection regarding the pending claims do not reasonably teach the features of either the specific designation discussed above, or any correlation section as is otherwise recited in the pending claims.

The examination history of this application to date adequately provides basis by which Applicants can reasonably assert that the Girgensohn reference fails to teach the features for which the current Office Action relies upon that reference as allegedly teaching. The previous Office Action conceded that Girgensohn failed to teach such features.

For at least the foregoing reasons, Girgensohn cannot reasonably be considered to teach, or to have suggested, the combinations of all of the features positively recited in independent

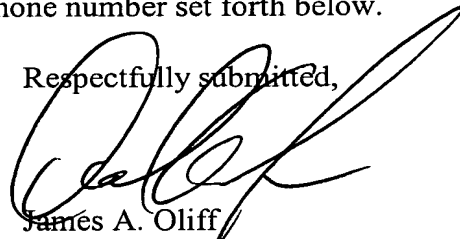
claims 1, 2, 5, 6 and 8. Further, claims 3, 7, 9-12 and 15-20 are also neither taught, nor would they have been suggested, by Girgensohn for at least the respective dependence of these claims directly or indirectly on allowable base claims, as well as for the separately patentable subject matter that each of these claims recites.

Accordingly, reconsideration and withdrawal of the rejection of claims 1-3, 5-12 and 15-20 under 35 U.S.C. §102(e) as being anticipated by Girgensohn are respectfully requested.

In view of the foregoing, Applicants respectfully submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-3, 5-12 and 15-25 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,



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JAO:DAT

Attachments:

Request for Continued Examination
Petition for Extension of Time

Date: October 9, 2008

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